

DOCKET NO: PHRM0028-101 (6195.NCN1)
Serial No.: 09/322,732

PATENT
Filed: May 28, 1999

REMARKS

Claims 4-8, 15-18 and 140-150 are pending. Claims 147-150 have been canceled without prejudice. Claims 7 and 8, and 143-146 have been amended to recite "binding activity". Claims 15-18, 140-142 have been canceled. Claims 151-163 have been added and are within the scope of the elected invention. Upon entry of this amendment claims 7, 8, 141, 143-146, and 151-163 will be pending. No new matter has been added.

As an initial matter, Applicants would like to thank Examiner Robinson for the courtesies extended during the February 17, 2004 teleconference to discuss the present case and claims on February 17, 2004. Applicants have incorporated the Examiner's suggestions into the current amendment.

Objections

The specification is objected to as allegedly containing "incorrect sentence structure." The Office alleges that the sentence "The identification of compounds that compete with the binding of radio-labeled oxazolidinones to 50S or 70S bacterial ribosomes and inhibit the formation of the translation initiation complex" is a dangling participle. Applicants respectfully disagree that the identified sentence is a dangling participle, but solely in an attempt to further prosecution, Applicants have removed this sentence from the specification, rendering the objection moot.

The amendment filed August 11, 2003 is objected to under 35 U.S.C. § 132 for allegedly introducing new matter into the disclosure. The Office alleges that amended claims 4, 5, 142, and 143 introduce new matter. According to the Office the added material that is allegedly not supported by the original disclosure is present in claims 4, 5, 142, and 143, in the recitations "wherein an increase in said intrinsic fluorescence of efp indicates that said compound increases said activity," or "wherein a decrease in said intrinsic fluorescence of efp indicates that said compound decreases said activity." The Office alleges that there is "no support in the instant specification for the conclusion drawn that an increase in intrinsic fluorescence of efp results in an increase in efp activity." (Office Action, page 3).

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Although Applicants disagree, Applicants respectfully assert that the objection is moot in view of the current amendments. The amendments have amended "activity" to "binding activity", support for which can be found throughout the specification as originally filed. The Office has stated that the specification is "enabled for a binding assay." (see, for example, Office Action, page 4). Therefore, Applicants respectfully assert that the claims currently pending do not contain new matter and respectfully request that the objection be withdrawn.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 4-8, 15-18 and 140-150 are rejected under 35 U.S.C. §, first paragraph, because the specification, while being enabling for a binding assay, allegedly does not reasonably provide enablement for the full scope of the claims. Applicants respectfully disagree, but in order to further prosecution Applicants have amended the claims to recite "binding activity". Accordingly, the claims are enabled.

In view of the foregoing, Applicants respectfully request that the rejection under 35 U.S.C. § 112, first paragraph be withdrawn.

Claims 4, 5, 142, and 143 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. This rejection is related to the new matter objection discussed above.

Applicants have amended the claims to remove the alleged new matter. The claims, as presently amended, recite "binding activity." Binding assays and binding activity are taught and described throughout the present specification. Accordingly, Applicants were in possession of the claimed invention at the time the application was filed.

In view of the foregoing, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 112, second paragraph

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Claims 4-8, 15-18 and 140-150 remain rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Although Applicants disagree and assert that the art-skilled would readily understand claims 4-8, 15-18 and 140-150, Applicants have amended the present claims to recite "binding activity." A person of ordinary skill in the art would understand what is meant by "binding activity". Therefore, the claims are clear and definite.

In view of the foregoing, Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.


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Conclusion

Applicants believe the claims are in condition for allowance. An early Notice of Allowance is therefore earnestly solicited. Applicants invite the Examiner to contact the undersigned at (215) 665-6928 to clarify any unresolved issues raised by this response.

Respectfully submitted,



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